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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,505	02/16/2006	Yuichi Matsuo	10842100127	1167

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ARENT FOX LLP  
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WASHINGTON, DC 20036

EXAMINER
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NGUYEN, CAM N

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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01/29/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
IPMatters@arentfox.com  
Patent\_Mail@arentfox.com

## Office Action Summary

**Application No.**

10/568,505

**Applicant(s)**

MATSUO ET AL.

**Examiner**

Cam N. Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/09/07 (an election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) 1, 3-5 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on originally filed is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>originally filed</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Response to Election/Restrictions

1. Applicant's election without traverse of Group I, claims 6-8, in the reply filed on 11/09/07 is acknowledged.
2. Claims 1, 3-5, & 9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 11/09/07.

### Claim Objections

3. Claim 6 is objected to because of the following informalities:
  - A. In claim 6, line 3, "kind of" should be deleted.
  - B. In claim 6, line 3, --consisting of-- should be inserted after "group".Appropriate correction is required.

### Claim Rejections - 35 USC § 112 (Second Paragraph)

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the limitation on “adding at least one compound selected from the group to an aqueous nitrate solution including a component” is unclear and does not particularly point out what material is being required by the claim. Thus, renders the claim vague and indefinite.

### Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

A. Claims 6-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5, 7, 14, & 16 of copending Application No. 11/032,233 (copending application ‘233). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The instantly claimed process appears to be broader in scope than the process disclosed in the copending application '233, which would inherently include the disclosed process steps and specific Pd nitrate and alkaline earth metal nitrate of the copending application '233.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

B. Claims 6-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 7,199,079 B2, which is copending application 10/919,486 (hereinafter referred as Pat '079). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The instantly claimed process appears to be broader in scope than the process disclosed in the copending application '233, which would inherently include the disclosed process steps and aluminum nitrate and rare earth nitrate of the Pat. '079.

**Claim Rejections - 35 USC § 102(b)**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Blanchard et al., "hereinafter Blanchard", (US Pat. 4,492,769).

Blanchard discloses a process of preparing a catalyst composition for treatment

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of internal combustion engine exhaust gas, comprising (i) coating and/or impregnating a support with a catalyst of palladium and at least one base metal element, (ii) activating the step (i) catalyst at a temperature ranging from 120°C to 800°C., (iii) next coating and/or impregnating the step (ii) activated catalyst with at least one platinum group precious metal other than palladium, or a combination of palladium and at least one other platinum group precious metal, and (iv) then activating the step (iii) catalyst at a temperature ranging from 300°C to 800°C (see col. 12- col. 13, claim 1). The at least one base metal element comprising a metal selected from a group of elements including the claimed alkaline earth metals (see col. 13, claim 4). Suitable catalyst support materials for the process comprising particulates of silica, alumina, etc., which includes the claimed aluminum oxide support (see col. 14, claim 11). Blanchard further discloses that a mineral or organic acid, such as nitric, phosphoric, etc. or acetic, citric and oxalic acids, or the like, can be added to the solution of the precious metals (see col. 5, ln 23-29). The reference also defined the term “activation” to mean heat treatment consisting of a drying process followed optionally by calcinations, which meets the claimed requirement of “evaporating and drying” and “heating” limitations (see col. 5, ln 11-14). The palladium nitrate and nitrate of the alkaline earth metals (barium nitrate) were used to prepare the catalyst solution in the disclosed process (see col. 8, Example 8).

There is no difference seen between the claimed process and the process disclosed by Blanchard. Thus, the claims are anticipated by the teaching of the reference.

9. Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizuno et al., “hereinafter Mizuno”, (US Pat. 6,500,392 B2).

Mizuno discloses a process of preparing Pd/Ba-pre-doped  $\text{Al}_2\text{O}_3$  in the same manner as applicants' claimed process, by adding a solution containing an aqueous palladium nitrate solution, an aqueous barium nitrate solution and an appropriate amount of acetic acid to commercial gamma-  $\text{Al}_2\text{O}_3$ , and then pulverizing in a ball mill for 15 hours. The resulting slurry was dried at  $100^\circ\text{C}$  for 15 hours, pulverized, and fired at  $700^\circ\text{C}$  for 3 hours to obtain Pd/Ba-pre-doped  $\text{Al}_2\text{O}_3$  powder, etc. (see col. 11, line 50-67, (Catalyst 15)). Mizuno teaches that the drying process followed optionally by calcinations, which meets the claimed requirement of "evaporating and drying" and "heating" limitations.

There is no difference seen between the claimed process and the process disclosed by Mizuno. Thus, the claims are anticipated by the teaching of the reference.

#### Citations

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared.

#### Conclusion

11. Claims 1 & 3-9 are pending. Claims 6-8 are rejected. Claims 1, 3-5, & 9 are withdrawn due to nonelected (distinct) invention(s). No claims are allowed.

#### Contacts

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is

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571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Nguyen/cnn

Primary Examiner

January 22, 2008

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